

APPENDIX XII

Serial No.: 09/955,064

Docket No.: 49933US031

Appellants' Brief on Appeal filed with the U.S. Patent and Trademark Office on
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PATENT
Docket No. 49933US031 (formerly 49933USA6H.031)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): HOOPMAN et al.) Group Art Unit: 1722
)
Serial No.: 09/520,032) Examiner: J. Leyson
Confirmation No.: 9385)
)
Filed: 6 March 2000)
)
For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

APPELLANTS' BRIEF ON APPEAL

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This Brief is presented in support of the Appeal filed April 25, 2002, from the final rejection of claims 17, 20, 21, 25-28, 33-54, 94-96, and 98-111 of the above-identified application under 35 U.S.C. § 102 (20, 21, 25-28, 33, 34, 36-45, 47-54, 94-96, 98, 99, 101-106, and 108-111) and 35 U.S.C. § 103 (claims 17, 20, 21, 25-28, 33-54, 94-96, and 98-111), as set forth in the Final Office Action mailed January 25, 2002.

This Brief is being submitted in triplicate, as set forth in 37 C.F.R. § 1.192(a). A check to cover the fee for filing this Brief under 37 C.F.R. § 1.17(f) is enclosed herewith.

I. REAL PARTY IN INTEREST

The real party in interest of the above-identified patent application is the assignee, 3M Innovative Properties Company.

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II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellants' Representatives which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 17, 19-21, 25-28, 33-54, 94-96, 98-111, and 133-175 are pending. Claim 19 having been indicated as allowed and claims 133-175 having been withdrawn, claims 17, 20, 21, 25-28, 33-54, 94-96, and 98-111 are the subject of this Appeal (see Appendix I).

IV. STATUS OF AMENDMENTS

A Preliminary Amendment (dated April 23, 2001, a copy enclosed, see Appendix II) was filed in the above-identified application (which is a divisional application of Serial No. 09/259,488, filed February 26, 1999, issued as U.S. Patent 6,076,248 on June 20, 2000, which is a divisional application of Serial No. 08/940,267, filed September 29, 1997, issued as 6,129,540 on October 10, 2000, which is a continuation application of Serial No. 08/450,814, filed May 25, 1995, now abandoned, which is a divisional application of Serial No. 08/120,300, filed September 13, 1993, now abandoned) in which Appellants added claims 22-87.

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A Supplemental Preliminary Amendment (dated May 4, 2001, a copy enclosed, see Appendix III) was filed in the above-identified application in which Appellants added claims 88-132 and amended previously submitted claims 23, 24, 56, and 57.

A Continued Prosecution Application was filed by Appellants under 37 C.F.R. § 1.53(d) along with a Preliminary Amendment (dated August 23, 2001, a copy enclosed, see Appendix V) in response to an Office Action mailed May 23, 2001, in which claims 1-132 were subjected to a restriction requirement (a copy enclosed, see Appendix IV). Claims 14-54 and 88-111 were elected with traverse by Appellants' Representative. Additionally, claims 16, 17, and 19-21 were rejected under 35 U.S.C. § 112, second paragraph, claims 14-16, 18, 22-24, 29-32, 88-93, and 97 were rejected under 35 U.S.C. § 102(e), claims 17, 20, 25-28, 33-54, 94-96, 98-111 were rejected under 35 U.S.C. § 103, and claims 19 and 21 were rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,129,540. In that Preliminary Amendment, Appellants cancelled claims 1-16, 18, 22-24, 29-32, 88-93, 97, and 112-132, and amended claims 17, 19-21, 33-54, 98-111. Appellants also filed a Terminal Disclaimer (a copy enclosed, see Appendix VI).

A Supplemental Preliminary Amendment was filed by Appellants (dated September 18, 2001, a copy enclosed, see Appendix VII) in which Appellants cancelled claims 55-87, amended claims 17, 19-21, 25-27, 33-54, 94-96, and 98-111, and added claims 133-175.

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A second nonfinal Office Action (a copy enclosed, see Appendix VIII) was mailed on September 27, 2001, in which claims 20, 21, 25-28, 33, 34, 36-45, 47-54, 94-96, 98, 99, 101-106, and 108-111 were rejected under 35 U.S.C. § 102(b), and claims 17, 20, 21, 33-54, and 98-111 were rejected under 35 U.S.C. § 103. Claim 19 was indicated as allowed. Claims 133-175 were withdrawn from consideration as nonelected subject matter.

Appellants filed an Amendment and Response (dated December 27, 2001, a copy enclosed, see Appendix IX) in which claims 17, 20-21, 25-28, 33-54, 94-96, 98-111, and 133-175 were amended. Each of the independent claims (except allowed claim 19) was amended to recite a production tool with a plurality of cavities, each of which has a single opening.

A final Office Action (a copy enclosed, see Appendix X) was mailed on January 25, 2002, in which the 35 U.S.C. §§ 102 and 103 rejections were maintained as described in the second nonfinal Office Action mailed on September 27, 2001. Also, several new rejections were presented. Claims 25-28 and 94-96 were rejected under 35 U.S.C. § 103, claim 40 was rejected under 35 U.S.C. § 112, second paragraph, and claims 17, 20, 21, 25-28, 33-54, 94-96, and 98-111 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

All amendments were entered.

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V. SUMMARY OF THE INVENTION

Appellants' invention is directed to a production tool for manufacturing an abrasive article. The production tool includes a plurality of cavities, each of which has a single opening. Various embodiments of the production tool are claimed.

VI. ISSUE(S) PRESENTED FOR REVIEW

1. Whether claims 25-28 and 94-96 are anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 3,312,583 (Rochlis '583).
2. Whether claim 20, 21, 33, 34, 36-45, 47-54, 98, 99, 101-106, and 108-111 are anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 3,312,583 (Rochlis '583).
3. Whether claims 17, 20, 21, 33-54, and 98-111 are obvious under 35 U.S.C. § 103 over U.S. Patent No. 3,312,583 (Rochlis '583).
4. Whether claims 17, 20, 21, 25-28, 33-54, 94-96, and 98-111 are obvious under 35 U.S.C. § 103 over U.S. Patent No. 3,312,583 (Rochlis '583).

VII. GROUPING OF CLAIMS

For the purpose of this appeal, claims 17, 20, 21, 25-28, 33-54, 94-96, and 98-111 stand or fall together.

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VIII. ARGUMENT

A. Claims 20, 21, 25-28, 33, 34, 36-45, 47-54, 94-96, 98, 99, 101-106, and 108-111 are not anticipated under 35 U.S.C. § 102(b) by Rochlis '583.

The standard for anticipation is one of strict identity. "It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention . . ."

Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

"In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'" In re Hoeksema, 399 F.2d 269, 158 U.S.P.Q. 596, 600 (CCPA 1968). "A reference contains an 'enabling disclosure' if the public was in possession of the claimed invention before the date of invention." M.P.E.P. § 2121.01.

1. Rochlis '583 does not disclose every element of the claimed invention.

Each of Appellants' independent claims recites a production tool for manufacturing an abrasive article having a plurality of cavities, each of which has a single opening. In contrast, the mold disclosed in Rochlis '583 requires a laminate construction with multiple openings (i.e., one opening per layer) (col. 3, lines 40-49). Specifically, these openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). There is no disclosure in Rochlis '583,

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however, that any cavity, let alone each of the cavities, has only a single opening. That is, there is no disclosure that Rochlis '583 has laminated mold constructions without openings between the mating surfaces of the laminations. Furthermore, there is no disclosure that Rochlis '583 has mold constructions with a single opening.

2. Rochlis '583 does not contain an enabling disclosure.

As stated above, Rochlis '583 does not disclose a production tool with any cavity, let alone each of a plurality of cavities, having only a single opening. Furthermore, Rochlis '583 does not teach how one of skill in the art would make a production tool for manufacturing an abrasive article with even one cavity having a single opening. Rochlis '583 is enabling for a laminated mold construction that includes openings between the mating surfaces of the laminations. There is no enabling disclosure in Rochlis '583 of how one of skill in the art would make a mold or production tool with only a single opening.

B. Claims 17, 20, 21, 25-28, 33-54, 94-96, and 98-111 are not obvious under 35

U.S.C. § 103 over Rochlis '583.

"When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

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(D) Reasonable expectation of success is the standard with which obviousness is determined." M.P.E.P. § 2141 (citations omitted).

1. Rochlis '583 does not teach or suggest the claimed invention.

Rochlis '583 does not explicitly teach or suggest a production tool with any cavity having only a single opening, let alone each of a plurality of cavities having only a single opening. Furthermore, Rochlis '583 does not explicitly teach or suggest how one of skill in the art would make a production tool for manufacturing an abrasive article with a cavity having a single opening. Rochlis '583 teaches how to make a laminated mold construction with openings between the mating surfaces of the laminations. From the disclosure of Rochlis '583, one of skill in the art would not know how to make a mold with only a single opening.

2. When considered as a whole, Rochlis '583 teaches away from the claimed invention.

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d 238, 147 U.S.P.Q. 391, 393 (CCPA 1965). A single statement in the prior art reference should not be taken out of context and relied upon with the benefit of hindsight to show obviousness; rather, a reference should be considered as a whole.

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Bausch & Lomb, Inc. v. Barnes-Hind/Hycrocurve, Inc., 796 F.2d 443, 230 U.S.P.Q. 416, 419-420 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987), on remand, 10 U.S.P.Q. 2d 1929 (N.D. Calif. 1989).

One of skill in the art would not be motivated to make a mold or production tool for manufacturing an abrasive article with a single opening as a result of the teachings of Rochlis '583. In fact, one of skill in the art would expect that a mold with only a single opening would not be functional since the openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). In effect, Rochlis '583 teaches away from Appellants' invention when its disclosure is considered as a whole.

3. It is impermissible to use hindsight as an obviousness test.

Appellants respectfully submit that the use of Rochlis '583 alone in an obviousness rejection can only occur by the impermissible use of hindsight reasoning. In order to establish a *prima facie* case of obviousness, the references must teach or suggest all the claim limitations. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 at 93 ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, . . . was a legally improper way to simplify the difficult determination of obviousness."). One cannot "simply [to] engage in a hindsight reconstruction of the claimed invention, using the

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Applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F2d 982, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). Further, both the suggestion for combining the teachings of the prior art to make the invention and the reasonable likelihood of its success must be founded in the prior art and not in the teachings of Appellants' disclosure. In re Dow Chem., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Here, the cited art neither suggests the combination of its teachings nor suggests the reasonable likelihood that such a combination would result in the present invention.

Appellants respectfully submit that the teachings of Rochlis '583 are woefully inadequate to teach or suggest any mold or production tool for manufacturing an abrasive article, wherein the tool has a plurality of cavities, each of which as a single opening. Impermissible hindsight was used to sift through the prior art in order to reconstruct the claimed invention using Appellants' specification as a template for selecting a particular teaching.

Furthermore, there is simply no teaching, suggestion, or incentive in Rochlis '583 to provide a motivation to modify its teachings to provide a mold or tool with cavities having only single openings, specifically in view of the fact that Rochlis '583 emphasizes the importance of the openings between the mating surfaces of the laminations (they allow for air or gas to be evolved in the molding or hardening procedure, col. 13, lines 70-73).

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C. Summary

For the many foregoing reasons, it is respectfully submitted that *prima facie* cases of anticipation and obviousness have not been established. It is earnestly requested that the Board reverse the Examiner's rejections, and that all of the claims be allowed. Appellants acknowledge the pending obviousness-type double patent rejection over copending Application No. 09/955,604 and, after patentability of the instant invention is confirmed, a Terminal Disclaimer will be filed if such a rejection is maintained, and the § 112, second paragraph rejection will be addressed by amending the claims as suggested by the Examiner. It is assumed that Appellants would be allowed to make such amendments and file a Terminal Disclaimer if needed since the first time these rejections appeared was in the final Office Action.

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